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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,509	02/27/2004	Steven W. Fowkes	STFO-00200	7424
28960	7590	03/28/2006	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			BOYKIN, TERRESSA M	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,509

Applicant(s)

FOWKES, STEVEN W.

Examiner

Terressa M. Boykin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Arguments

Applicant's arguments filed 12-27-05 have been fully considered but they are not persuasive.

Applicants' claims 1-33 remain so broadly set forth that the claim continues to be interpreted by the Examiner as anticipated by the several references while remaining within the scope of the specification. It should be noted that in order to prosecute the case resourcefully and expediently while giving the applicants the best possible search, it is imperative and practical to the expedition of prosecution for the applicants to clarify how amide linkages with hetero-atoms positioned beta relative to nitrogen atoms are incorporated/formed or what structural formula is contained in the composite therein. Without such clarity of structure, the art of record is within the scope of the present claims. Note applicants own structural drawings 1-11.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-33 are rejected under 35 U.S.C. 102(a, b, or e) as being

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anticipated by Ataei, Mehdipour et al. see abstract and structure provided; WO 9603114 see abstract and structure provided; JP 2000273319 see abstract provided; Hajipour, Absol Reza et al. see abstract and structure provided; Macdonald, Robert et al. see abstract and structure provided; and JP 2001106909 see abstract and structure provided.

Since the language of applicants claims continue to be broadly defined* and lacking in any definite or structural substance, each of the references discloses a composition polymer with amide linkages with hetero-atoms positioned beta relative to nitrogen atoms forming the amide linkages. prepared from the same components as claimed by applicants. Note applicant(s) "comprising" is open language and does not exclude those additional moieties etc. disclosed herein. Any properties or characteristics inherent in the prior art, although unobserved or detected by the reference, would still anticipate the claimed invention. Note In re Swinehart, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art". It is noted that composite materials containing binders is also exhaustively well-known. Since the disclosed composite materials are expressed differently in each instance in the reference and thus may be distinct from those claimed, it is incumbent upon applicant(s) to establish that they are in fact different by providing a clear and concise composite description or structural formula. In view of the above, there appears to be no significant difference between the references and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

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*It should be noted that the word/structural search based on applicant's language cited 2,498 compounds.

35 USC 112, Second Paragraph

Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawing at the time the application filed in order to achieve a complete exploration of the applicants' invention and its relation to the prior art. In re Zletz, 893 F. 2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989) In the instant case, Applicants claim 1 etc. does not define the invention in terms that clearly define the invention. The recited "system" has numerous definitions and intended meanings in the art. It is also noted, while a term used in the claims may be given a special meaning in the description of the invention, generally no term may be given a meaning repugnant to the usual meaning of the term. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

35 USC 112, Second Paragraph

Claims 1- 33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the broadly defined "system" the specification on page 2-5 specifically discloses particularly defined polymers, block polymers, heterocyclic structures and multi-cyclic structures that are not commensurate

in scope with these claims.

Although the CCPA has criticized the use of the characterization "too broad" or "undue breadth"....however, an application whose claim(s) are of a breadth which are not adequately supported by its specification is in violation of 35 USC 112, first paragraph. In re Borkowski et al., (CCPA 1970) 424 F2d 904; In re Wakefield, (CCPA 1970 422 F2d 897; In re Hammack, (CCPA 197).

Again, it should be noted that applicant's amendments, although appreciated, does not assist in the expedient prosecuting of the claimed invention in that the Examiner continues to be unable to clearly define the invention in order that an appropriate and more exact search be accomplished. It is the desire of the Examiner to thoroughly search the invention. However, as the applicant should be aware, it is through the joint effort of both the Examiner and the applicants.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov <<http://www.uspto.gov>>), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <<http://www.uspto.gov/ebc/index.html>> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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Business Center (EBC) at 866-217-9197 (toll-free)

tmb


Examiner Terressa Boykin

TERRESSA M. BOYKIN
JULY EXAMINER